UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,017	03/02/2004	Naoto Yajima	249455US0	3570

22850 7590 12/18/2006

C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
BERNATZ, KEVIN M	
ART UNIT	PAPER NUMBER
1773	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/790,017	YAJIMA ET AL.	
	Examiner	Art Unit	
	Kevin M. Bernatz	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 6-8 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☑ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendments to the specification and claims 6 and 7, filed on September 13, 2006, have been entered in the above-identified application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC § 103

3. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Stewart et al. (U.S. Patent No. 5,356,682).

Regarding claim 6, Stewart et al. disclose a linear-recording magnetic tape (*Title and Figures*) comprising a top face, a bottom face, a side edge on a reference edge, and a side edge on the other side, said side edges being along the longitudinal direction of said tape (*Figures and inherent to tape per Figure I below*), wherein said edge on the reference edge side is shorter in length than on the other side (*i.e. a diagonally cut film to facilitate splicing: Figure 7 and col. 1, lines 1 – 64*).

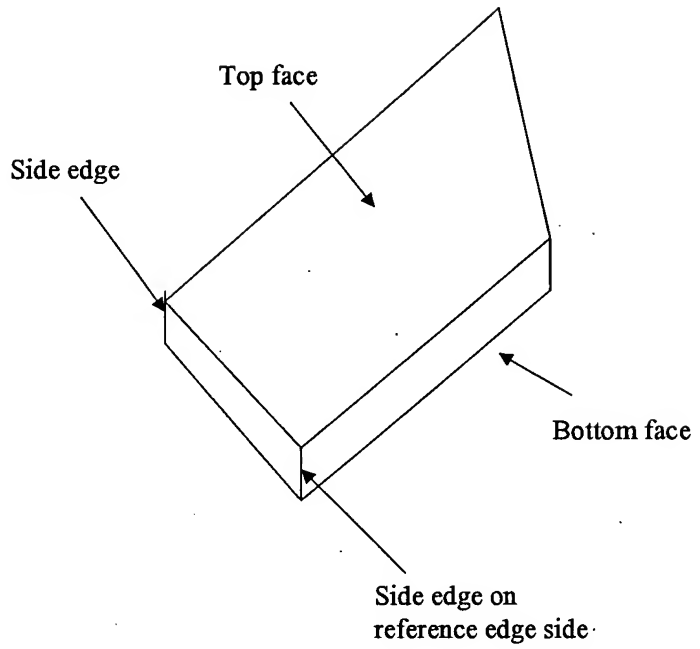

Figure I: Illustration of a standard tape and the claimed edges

The limitation(s) "said side edge on the reference side edge being the edge from which positions of tracks in the width direction of the tape are determined by distance" is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. Note that "in apparatus, article, and composition claims, intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459

(CCPA 1963). See MPEP § 2111.02. In the instant case, the disclosed magnetic tape can be used in situations where the side edge on the reference side is where the tracking positions are taken from, or from the other side with no effect on the disclosed performance of the tape. I.e. the prior art is deemed to be clearly capable of performing the intended use and the claimed limitations do not result in a structural difference between the claimed and prior art products.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 6 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori et al. (U.S. Patent No. 5,958,565) in view of Stewart et al. ('682).

Regarding claim 6, Hattori et al. disclose a linear-recording magnetic tape (*Title and Figures*) comprising a top face, a bottom face, a side edge on a reference edge, and a side edge on the other side, said side edges being along the longitudinal direction of said tape (*Figures and inherent to tape per Figure I above*).

The limitation(s) "said side edge on the reference side edge being the edge from which positions of tracks in the width direction of the tape are determined by distance" is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. Note that "in apparatus, article, and composition claims, intended

use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the disclosed magnetic tape can be used in situations where the side edge on the reference side is where the tracking positions are taken from, or from the other side with no effect on the disclosed performance of the tape. I.e. the prior art is deemed to be clearly capable of performing the intended use and the claimed limitations do not result in a structural difference between the claimed and prior art products.

Hattori et al. fail to explicitly disclose controlling the edge lengths to meet applicants' claimed limitations.

However, Stewart et al. teach that it is known in the art to cut a film at a diagonal inorder to facilitate splicing, thereby resulting in a film wherein one lateral edge is longer in length than the opposite side lateral edge (*Figure 7 and col. 1, lines 1 – 64*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Hattori et al. to possess edge lengths meeting applicants' claimed limitations as taught by Stewart et al. since such a structure facilitates splicing.

Regarding claim 7, Hattori et al. disclose measuring curl (i.e. "curvature") in substantially the same manner as applicants and controlling the curvature to be within applicants' claimed range limitations (*Figure and col. 17, line 59 bridging col. 18, line 43*).

Regarding claim 8, Hattori et al. disclose magnetic layer thickness values meeting applicants' claimed limitations (*col. 18, lines 44 – 52*).

Response to Arguments

6. The rejection of claim 6 under 35 U.S.C § 102(b) – Stewart et al.

Applicant(s) arguments have been considered but are moot in view of the new ground(s) of rejection.

7. The rejection of claims 6 - 8 under 35 U.S.C § 103(a) – Hattori et al. in view of Stewart et al.

Applicant(s) arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicants' amendment resulted in embodiments not previously considered (i.e. amended language of claim 6) which necessitated the new grounds of rejection, and hence the finality of this action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
November 21, 2006

Kevin M. Bernatz, PhD
Primary Examiner